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CASE A-22082/P2/CGC 2041

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

GLEN T. CUNKLE ET AL

APPLICATION NO: 09/658,924

FILED: SEPTEMBER 11, 2000

FOR: CHLOROHYDRIN AND CATIONIC

COMPOUNDS HAVING HIGH AFFINITY

FOR PULP OR PAPER

Group Art Unit: 1731

Examiner: M. Alvo

Response Under 37CFR 1.116-
Expedited Procedure-
Examining Group 1731

Commissioner for Patents
Washington, D.C. 20231

RESPONSE AFTER FINAL REJECTION

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Sir:

In response to the Office Action, Paper No. 6, dated Dec. 4, 2001, the following amendments and remarks are respectfully submitted for entry and consideration. The Action finally rejects the present claims. The Examiner is kindly requested to enter this response even though it is submitted after final rejection. This response simply clarifies the present situation; therefore consideration thereof will require little additional effort and will expedite the prosecution of this application.

This response is timely filed and no petition for an extension of time is required.

Rejections under 35 USC 112, first paragraph

Claims 1-10 are rejected under 35 USC 112, first paragraph, for reasons of record.

Applicants respectfully traverse these rejections.

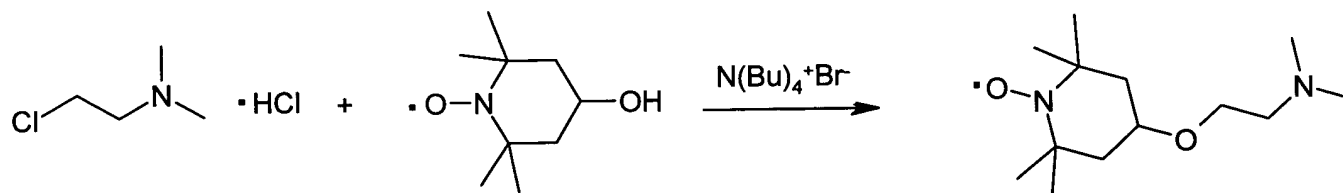
The Examiner objects that the Amendment filed Sept. 17, 2001 adds new matter to the specification, and therefore changes the scope of the claims. The Examiner states that the compound of Example 18 was changed.

In fact, the Amendment corrects the name given for the compound of Example 18, and does not at all change the actual compound described. As seen in the Appendix to the Amendment of Sept. 17, 2001, "propyl" is deleted to correctly insert "ethyl" in the name. Hereinafter referred to as the "propyl", or "incorrect" name, and the "ethyl", or "correct" name.

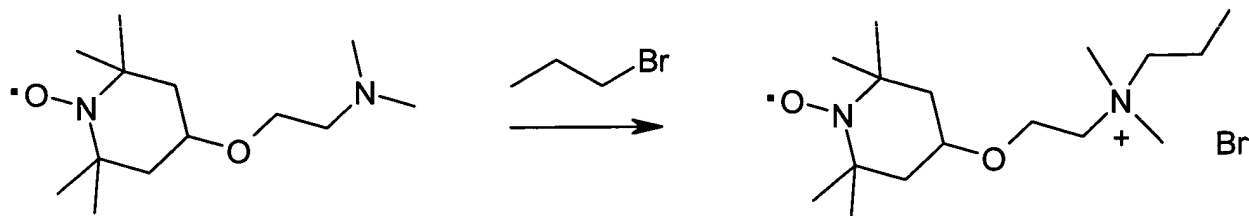
Example 18 states that the title compound is prepared according to Example 16 by replacing propyl bromide with 1,6-dibromohexane. The "ethyl" moiety is further traced back to example 14. It is clear therefore that the correct name of the compound of Example 18 must be as in the previously presented amendment. Still further, mass spectroscopy data is given in Example 18 that is consistent with the correctly named ("ethyl") compound.

For the convenience of the Examiner, a schematic of present working Examples 14, 16 and 18 are given here:

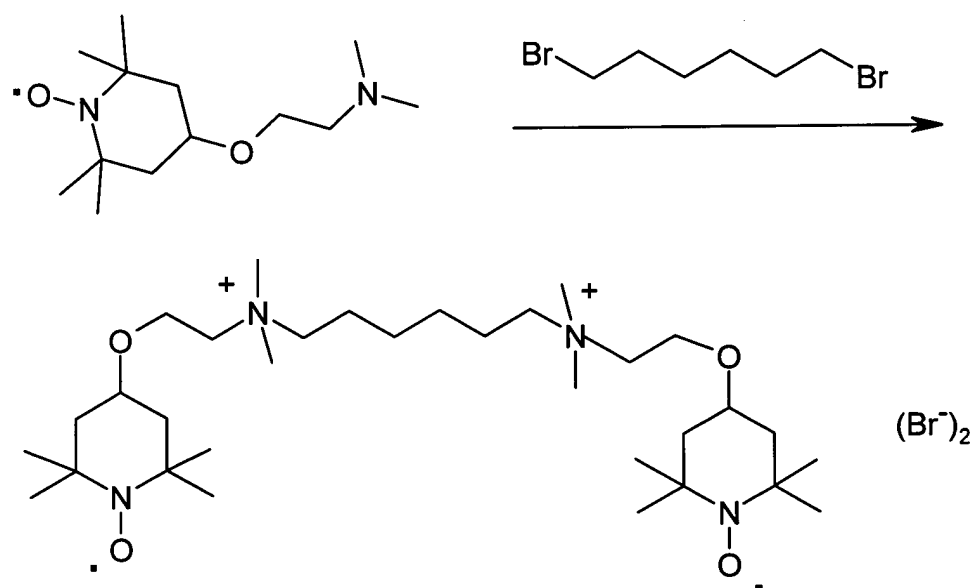
Example 14



Example 16



Example 18



Applicants submit that it is clear that the amendment to the specification previously filed simply corrects an inadvertent error in nomenclature. There is suitable evidence that the compound of Example 18 is in fact the "ethyl" compound. Applicants aver that no new matter is added by correcting the name of the compound of Example 18.

Applicants aver that in light of the present discussion, that the 35 USC 112, first paragraph rejections are addressed and are overcome.

Restriction under 35 USC 121

In a telephone conversation with Examiner Alvo June 7, 2001, the undersigned Agent, Tyler Stevenson, provisionally elected with traverse as the single disclosed species the compounds of formula VIII of claim 1. This election was confirmed in the Amendment filed Sept. 17, 2001.

For the convenience of the Examiner, Applicants pointed out that the compound of present Example 18 is an example of a compound that falls under this definition.

The correction of the compound of Example 18 does not change the elected species. Both the correctly named compound ("ethyl") and the incorrectly named compound ("propyl") fall under the elected species. The claims then are still drawn to the elected species.

Applicants apologize for the inconvenience caused for the Examiner having searched the "propyl" compound instead of the "ethyl" compound. However, both compounds are of the elected species. That is, they both fall under the compounds of formula VIII of claim 1.

Claim rejections under 35 USC 102(a) or (e) or 35 USC 103(a)

Claims 1-10 are rejected under 35 USC 102(a) or (e) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over WO 99/05108 (WO '108).

The Examiner repeats the rejections of the Office Action of June 12, 2001.

Applicants respectfully point out that they did not previously state that the present process differs from that of WO '108.

Applicants did point out in the Amendment filed Sept. 17, 2001 the structures of the compound of example (g) of page 55 of WO '108 and the compound of present Example 18.

Applicants reiterate that there is no overlap of either the present "propyl" compound or the correct "ethyl" compound of Example 18 (illustrated above) with example (g), page 55 of WO '108.

Further, there is no possible overlap of any of the compounds of the present claims with those described in WO '108.

The Examiner is not correct in his analysis of the subgroup "m" of the present compounds. The term "m" is an integer from 2 to 6 as stated in claim 1 (page 42). The term "m" may not be a hydroxyl group as the Examiner states.

In light of the fact that there is no possible overlap of the compounds of the present claims with those of WO '108, Applicants submit that the present claims are not anticipated by the disclosure of WO '108, nor can the present claims be obvious over the cited reference.

In light of this discussion, Applicants submit that the 35 USC 102(a) or (e) and the 35 USC 103(a) rejections are addressed and are overcome.

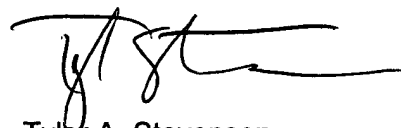
Applicants submit that in view of all of the above discussion, and the Amendment filed Sept. 17, 2001, that all of the present rejections under 35 USC 112, first paragraph, 35 USC 102(a) or (e) and 35 USC 103(a) are obviated.

Applicants respectfully request the Examiner to reconsider and to withdraw the present rejections.

Applicants aver that the present claims are in condition for allowance and respectfully request that they be found allowable.

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Respectfully submitted,



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